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LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA, VA 22314

EXAMINER	
CHOI, PETER H	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/863,268	KRAFT ET AL.	
	Examiner	Art Unit	
	Peter Choi	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This **FINAL** Office Action is responsive to Applicant's amendment filed 9/16/05. Applicant has amended claims 1-27, which are pending in the application.

Claim Rejections - 35 USC § 112

2. The previous 35 USC § 112 rejection made in the Office Action dated July 7, 2005 is withdrawn in view of the Applicant's amendment to claims 2 and 7.

Claim Rejections - 35 USC § 101

3. The previous 35 USC § 101 rejection made in the Office Action dated July 7, 2005 is withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8, 14-22, 24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al (U.S Patent #6,675,151)

As per claim 1, Thompson et al. teaches a computer-based **(computer implemented) (computer implemented)** system utilizing an event matching system for service providers based on an unexpected change in a schedule of service or event, said system comprising:

a window of opportunity event generator **(substitute fulfillment system)**, said generator automatically identifying said unexpected change in schedule of service or event **(employee absence)** [Column 2, lines 5-7, Column 4, line 64 – Column 5, line 2];

a distribution channel analyzer, said analyzer analyzing an event **(employee registering an absence)**, as identified by said window of opportunity event generator system, based on data and rules **(qualifications required for acceptable substitutes)** [Column 2, lines 34-38];

an event matcher, said matcher receiving an analyzed event from said distribution channel analyzer and integrating information **(contact data, notification information)** from a database **(of registered substitutes and potential replacements/substitutes)** to select a service provider for said event [Column 2, lines 34-38, Column 5, lines 9-12]; and

an accounting manager, said manager providing an accounting functionality **(billing information for billing substitute fulfillment services 100)** for the service

provider by analyzing events as obtained from said event matcher [Column 9, lines 35-37, Figure 3].

It is old and well known in the art that databases may be accessed internally (as coupled with a computer system) or externally with the same functionality. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include an external database, as it will reduce the number of incorrectly inputted data, and enable companies to avoid the costs associated with maintaining and updating information if using outsourced third party databases.

As per claim 2, Thompson et al. teaches a computer-based **(computer implemented) (computer implemented)** system that utilizes an event matching system for service providers **(potential replacements/substitutes)** based on an unexpected change in a schedule of service **(absent employees)**, as per claim 1, wherein said external database utilizes a service provider profile database, said service provider profile database containing informational data of said service providers **(registered substitutes and potential replacements/substitutes)** [Column 3, lines 51-54].

As per claim 3, Thompson et al. teaches a computer-based **(computer implemented)** system that utilized an event matching system for service providers

based on an unexpected change in a schedule of service **(employee absence)**, as per claim 1, wherein said system further utilized an event database, said database storing data of said events **(database 34 that includes historical system use information)** as related by said event matcher [Column 12, lines 48-49].

As per claim 4, Thompson et al. teaches a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service **(employee absence)**, as per claim 1, wherein said distribution analyzer further utilizes a channel rules database containing rules to be applied **(qualifications required for acceptable substitutes)** to particular data receiving channels [Column 2, lines 34-38].

As per claim 5, Thompson et al. teaches a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service **(employee absence)**, as per claim 1, wherein said data and rules of said distribution channel analyzer further utilize an institutional or organizational database, said databases containing additional informational data of selected institutions or organization **(prepared lists of candidates, or potential substitutes, substitution criteria, registered substitutes, etc.)** [Column 2, lines 35-38, Column 3, lines 51-54].

As per claim 6, Thompson et al. teaches a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service, as per claim 1, wherein said system further utilizes a subscription management service **(only authorized parties of interest can access)** wherein said events **(unexpected events, benefits, policies and daily announcements)** and schedules are defined for tracking [Column 5, lines 17-25 and 51-60].

As per claim 7, Thompson et al. fails to teach a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service, as per claim 2, wherein said system further utilizes a service provider profile manager for said service provider database, said manager allowing service providers to customize and manage profile data in said service provider database. However, Official Notice is taken that it is old and well known in the art that users would modify their profile to reflect updated skills, availability, qualifications, and services provided. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include means to allow users to modify their profile in order to provide an accurate representation of their skills and abilities that are needed to evaluate the user's qualifications to provide services.

As per claim 8, Thompson et al. fails to teach a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service, as per claim 5, wherein said data and rules of said distribution channel analyzer further utilize an institutional or organizational profile manager, said manager allowing institutions or organizations to customize and manage profile data in said database. However, Official Notice is taken that it is old and well known that institutions and organizations would modify their profile to reflect updated skills, qualifications, services provided, needs, or qualifications required. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include means to allow institutions and organizations to modify their profile in order to provide an accurate representation of their skills, abilities, and requirements that are needed to evaluate their qualifications to provide services, or to evaluate services needed.

As per claim 14, Thompson et al. teaches a computer-based **(computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service or event, said system comprising:

a window of opportunity event generator **(substitute fulfillment system)**, said generator automatically identifying said unexpected change in schedule of service or event **(employee absence)** [Column 2, lines 5-7, Column 4, line 64 – Column 5, line 2];

a distribution channel analyzer, said analyzer analyzing an event **(employee registering an absence)**, as identified by said window of opportunity event generator system, based on data and rules **(qualifications required for acceptable substitutes)** [Column 2, lines 34-38];

a service provider profile database, said database containing informational data **(contact data, notification information)** of said service providers **(registered substitutes and potential replacements/substitutes)** [Column 5, lines 9-12];

an event database, said database used for storing data **(information on employee absences, and historical system use information)** of said events [Column 5, lines 46-50 and Column 12, lines 48-49];

a channel rules database containing rules **(a list of criteria for selecting an appropriate substitute 104, flags for special conditions 122)** to be applied to particular channels [Column 9, lines 37-45];

an event matcher, said matcher receiving an analyzed event from said distribution channel analyzer and integrating information **(contact data, notification information)** from a database **(of registered substitutes and potential replacements/substitutes)** to select a service provider for said event [Column 2, lines 34-38, and Column 5, lines 9-12];

It is old and well known in the art that databases may be accessed internally (as coupled with a computer system) or externally with the same functionality, thus making the database taught by Thompson et al. meet the limitations of the claim.

As per claim 15, Thompson et al. teaches an e-commerce method for enhancing sales of service providers **(temporary employment substituting for absent employees)**, said service providers in communication across networks and available to provide one or more specific services through directed sales to selected customers **(organizations requiring temporary, replacement or substitute workers)**, said method comprising:

automatically detecting one or more opportunities for sales **(temporary employment)** based on an unexpected change in schedule of a service **(employee absence)** or an event [Column 2, lines 5-7, Column 4, line 64 – Column 5, line 2];

analyzing said opportunity using a set of data and rules **(a list of criteria for selecting an appropriate substitute 104, flags for special conditions 122)**, said data and rules stored locally **(database)** or remotely in computer storage [Column 9, lines 37-45];

matching said analyzed opportunity **(need for substitute/replacement employee)** with integrated information from a subscriber profile database **(qualifications)** to select one or more of said service providers **(potential substitutes)** [Column 15, lines 26-30];

notifying said selected service provider **(potential substitutes, interested parties, designated groups of people)** of said opportunity for sales [Column 13, lines 19-20 and 39-48 and Column 15, lines 32-35]; and

providing an accounting functionality **(billing information for billing substitute fulfillment services 100)** for said service provider **(potential substitute)** by analyzing events and transactions of actual sales **(potential substitute fulfilling need for worker substitution)** [Column 9, lines 35-37, Figure 3].

As per claim 16, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 15, wherein said integrated information further comprises the use of a service provider profile database **(containing informational data of registered substitutes and potential replacements/substitutes)** [Column 3, lines 51-54].

It is old and well known in the art that databases may be accessed internally (as coupled with a computer system) or externally with the same functionality, thus making the database taught by Thompson et al. meet the limitations of the claim.

As per claim 17, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 15, wherein said method further comprises storing data of said events in an event database **(database 34 that includes historical system use information)** [Column 12, lines 48-49].

As per claim 18, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 15, wherein said method further comprises

obtaining rules **(qualifications required for acceptable substitutes, substitution criteria)** from a channel rules database to be applied to particular channels [Column 2, lines 34-38 and Column 3, lines 51-53].

As per claim 19, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 16, wherein said method further comprises obtaining rules **(substitution criteria)** from a database containing data of selected institutions or organizations in which events may take place **(employees notify organization of absences)** [Column 3, lines 51-53].

As per claim 20, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 15, wherein said method further comprises tracking events **(employee absences)** and schedules **(schedule information)** of subscribed service providers **(availability of potential substitutes, substitute schedule information that is stored in data record 403)** or consumers **(workers who register an absence)**. [Column 5, lines 32-33, Column 9, lines 40-43, and 50-54]

As per claim 21, Thompson et al. fails to teach an e-commerce method for enhancing sales of service providers, as per claim 16, wherein said method further comprises managing and customizing profiles of service providers in said service provider profile database.

However, Official Notice is taken that it is old and well known in the art that users would modify their profile to reflect updated skills, availability, qualifications, and services provided. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include means to allow users to modify their profile in order to provide an accurate representation of their skills and abilities that are needed to evaluate the user's qualifications to provide services.

As per claim 22, Thompson et al. fails to teach an e-commerce method for enhancing sales of service providers, as per claim 19, wherein said method further comprises managing and customizing profiles of institutions or organizations in said institutional/organizational profile database.

However, Official Notice is taken that it is old and well known that institutions and organizations would modify their profile to reflect updated skills, qualifications, services provided, needs, or qualifications required. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include means to allow institutions and organizations to modify their profile in order to provide an accurate representation of their skills, abilities, and requirements that are needed to evaluate their qualifications to provide services, or to evaluate services needed.

As per claim 24, Thompson et al. teaches an e-commerce method for enhancing sales of service providers, as per claim 20, wherein said method further comprises storing a consumer's profile **(worker identification, contact information, qualifications)** in a database [Claim 9 and Column 15, lines 26-29].

As per claim 26, although not taught by Thompson et al., the step of managing and customizing profiles of consumers in said consumer profile database is old and well known in the art. Using consumer profiles would provide the benefit of establishing a collection of data about consumers that contain descriptive information emphasizing specific skills and abilities that may make themselves a more attractive candidate for providing a service. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined teachings of Thompson et al. to include the step of customizing consumer profiles to be stored in databases to enable service providers with a means of distinguishing and marketing themselves from other candidates.

As per claim 27, Thompson et al. teaches an article of manufacture comprising a computer program product, said computer program product comprising a computer readable medium storing processor-executable program code, said computer readable program code embodying a method comprising the steps of:

automatically detecting one or more opportunities for sales **(need for a substitute or replacement worker)** based on an unexpected change in schedule of

service or event **(employee absence)** [Column 2, lines 5-7, Column 4, line 64 – Column 5, line 2];

analyzing said opportunity **(need for a substitute or replacement worker)** using a set of data and rules **(qualifications required for acceptable substitutes, a list of criteria for selecting an appropriate substitute 104, flags for special conditions 122)** [Column 2, lines 34-38 and Column 9, lines 37-45];

matching said analyzed opportunity **(need for substitute/replacement employee)** with integrated information from a service provider profile database to select a service provider **(potential substitutes)** [Column 15, lines 26-30];

notifying said selected service provider **(potential substitutes, interested parties, designated groups of people)** of said opportunity for sales [Column 13, lines 19-20 and 39-48 and Column 15, lines 32-35]; and

providing an accounting functionality **(billing information for billing substitute fulfillment services 100)** for said service provider **(potential substitute)** by analyzing events and transactions of actual sales **(potential substitute fulfilling need for worker substitution)** [Column 9, lines 35-37, Figure 3].

6. Claims 9-13, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. in view of Robert English's "Locked in Your Car? You Can Choose Who Helps You In And Out Of Your Jam" (hereafter referred to as English).

As per claim 9, although not taught by Thompson et al., English teaches a **computer-based (computer implemented)** system that utilizes an event matching system for service providers **(OnStar)** based on an unexpected change in a schedule of service **(accident, automobile crash)**, as per claim 6, wherein said system further utilizes a location tracker **(GPS system and cellular network)**, said tracker used to keep track of subscribed consumers **(OnStar members)**.

Both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified unscheduled/unplanned events; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the location tracker as taught by English to determine the location of the user, enabling an evaluation of nearby service providers most suitable to provide prompt service that meet the needs of the user.

As per claim 10, neither Thompson et al., nor English teaches a **computer-based (computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service, as per claim 9, wherein said location tracker further utilizes a consumer profile database for storing consumers' informational data. However, it is old and well known in the art that service providers keep historical records of vehicle/employee usage, the services provided, the technicians who performed the services, the customers serviced, and the

location (or address) where the service was provided. Storing service information (what kind of services were provided, and where) in a database would enable data mining analysis to determine if specific areas have higher frequency of services required. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the step of storing consumer informational data to create a collection of relevant historical data regarding the location where services are supplied, and enable service providers to use data mining methods to develop customized services in specific locations.

As per claim 11, although not taught by Thompson et al., English teaches a **computer-based (computer implemented)** system that utilizes an event matching system for service providers **(OnStar)** based on an unexpected change in a schedule of service **(accident, automobile crash)**, as per claim 9, wherein said system further utilizes a location generator, wherein said generator is a tracking device **(GPS system and cellular network)**. While English does not specifically teach that the tracking device is used to transmit location data continuously to the location tracker, it is old and well known in the art that GPS receivers continuously transmit location data to tracking systems, meeting the limitation of the claim.

Both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified unscheduled/unplanned events; therefore, it would have been obvious to one of

ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the location tracker as taught by English to determine the location of the user, enabling an evaluation of nearby service providers most suitable to provide prompt service that meet the needs of the user.

As per claim 12, although not taught by Thompson et al., English teaches a **computer-based (computer implemented)** system that utilizes an event matching system for service providers **(OnStar)** based on an unexpected change in a schedule of service **(accident, automobile crash)**, as per claim 10, wherein said generator tracking device utilizes: GPS and wireless system.

Both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified unscheduled/unplanned events; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the location tracker devices as taught by English to determine the location of the user, enabling an evaluation of nearby service providers most suitable to provide prompt service that meet the needs of the user.

As per claim 13, neither Thompson et al., nor English teaches a **computer-based (computer implemented)** system that utilizes an event matching system for service providers based on an unexpected change in a schedule of service, as per

claim 11, wherein said location tracker further utilizes a consumer profile manager, wherein said manager allows consumers to customize and manage profile data in said database. However, it is old and well known in the art that linking the location tracker to the customer's profile would enable a service provider brokering system to determine customer usage and preferences (in terms of service providers), and attempt to find a service provider nearby who meets customer preferences and is qualified to provide service. Customizing and managing profile data in a database would enable data mining analysis to determine if specific customer segments have any specific tendencies (with regard to frequency of services, types of services, etc.). It would have been obvious to one of ordinary skill in the art to modify the teachings of Thompson et al. to include the step of customizing and managing consumer profile data since it would allow a service provider to employ data mining methods to develop targeted marketing strategies and offers directed towards specific customers, which may lead to increased revenue, and customer satisfaction, loyalty and retention.

As per claim 23, although not taught by Thompson et al., English teaches an e-commerce method for enhancing sales of service providers, as per claim 20, wherein said method **(OnStar)** further comprises utilizing a device **(GPS system and cellular network)** to keep track of the locations of subscribed consumers.

Both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified

unscheduled/unplanned events; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the location tracker as taught by English to determine the location of the user, enabling an evaluation of nearby service providers most suitable to provide prompt service that meet the needs of the user.

As per claim 25, although not taught by Thompson et al., English teaches an e-commerce method for enhancing sales of service providers, as per claim 23, wherein said device utilizes a **GPS system and cellular network**.

Both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified unscheduled/unplanned events; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Thompson et al. to include the location tracker devices as taught by English to determine the location of the user, enabling an evaluation of nearby service providers most suitable to provide prompt service that meet the needs of the user.

Response to Arguments

7. Applicant's arguments filed 9/16/05 have been fully considered but they are not persuasive.

It is noted that the Applicant did not challenge the statements of concepts that were old and well known at the time of invention, as cited in the first Office Action mailed July 7, 2005; therefore, those statements are presented herein as prior art.

Specifically, it is old and well known in the art that:

- Institutions and organizations would modify their profile to reflect updated skills, qualifications, services provided, needs, or qualifications required
- Databases may be accessed internally (as coupled with a computer system) or externally with the same functionality.
- Managing and customizing consumer profiles provides the benefit of establishing a collection of data about consumers that contain descriptive information emphasizing specific skills and abilities that may make themselves a more attractive candidate for providing a service.
- Service providers keep historical records of vehicle/employee usage, the services provided, the technicians who performed the services, the customers serviced, and the location (or address) where the service was provided.
- Storing service information (what kind of services were provided, and where) in a database would enable data mining analysis to determine if specific areas have higher frequency of services required.
- GPS receivers continuously transmit location data to tracking systems.

- Linking the location tracker to the customer's profile would enable a service provider brokering system to determine customer usage and preferences (in terms of service providers), and attempt to find a service provider nearby who meets customer preferences and is qualified to provide service.
- Customizing and managing profile data in a database would enable data mining analysis to determine if specific customer segments have any specific tendencies (with regard to frequency of services, types of services, etc.).

Applicant argues that Thompson et al. does not automatically identify windows of opportunity, nor automatically detect opportunities, relying entirely upon user input. The Applicant further argues that Thompson et al. neither automatically identifies unexpected changes, nor automatically detects opportunities based on unexpected changes. Applicant further argues that Thompson et al. does not employ data mining or extracting techniques that would enable automatic identification or detection of unexpected changes, instead, the existence of unexpected changes is required to be entered manually into the system by a worker or administrator.

The Examiner respectfully disagrees. In the amendment filed 9/16/05, the Applicant themselves have identified a plurality of passages of the Thompson et al.

reference that provides support that windows of opportunity are automatically detected/identified.

The Applicant has cited Column 5, lines 18-26.

Specifically, in lines 24-26: "Yet another embodiment encompasses a system which tracks information regarding workers' absences and entitlements".

From this citation, it is clear that the Thompson et al. reference tracks worker absence information. The system taught by Thompson et al. does not limit itself by stating a dependence on other human operators; thus, since the system is computer implemented, it can be inferred that the system taught by Thompson et al. is automated.

The Applicant has cited Column 10, lines 17-45.

Specifically, in lines 19-21: "The substitute fulfillment operation is initiated when the system 10 identifies and schedules an absence in step 78".

This passage clearly states that the *system* identifies absences. Again, as Thompson et al. is computer implemented, upon identification of an absence, the substitute fulfillment operation is automatically initiated.

In lines 23-29: "When a worker 18, 46 covered by the system 10 becomes aware of an absence, the worker 18, 46 may contact the communications and processing server 30 by telephone 48, preferably through a toll-free number. Using keys on the standard telephone keypad, the worker 18, 46 identifies himself and enters the details of his pending absence using a standard telephone keypad."

Since this step allows the user to enter said information using a telephone instead of interacting with another person, this step has been automated; thus, the information is provided to the system of Thompson et al. where a window of opportunity will be automatically identified.

In lines 30-34: "Alternatively, the worker 18, 46 may contact the communications and processing server 30 via the Internet 26, possibly using a home-based computer 20, through a worker web site that is preferably secure."

From this passage, it is again clear that the user enters information without interacting with another person, evidence that this step is automated. Again, the step of data collection has been automated and provided to the substitute fulfillment system; thus the system of Thompson et al. is enabled to automatically identify a window of opportunity.

In lines 38-46: "In one embodiment, if the worker 18, 46 notifies the organization 56, rather than the system 10, of the absence directly, the organization 56 may simply update its applet and connect to the communications and processing server 30, which process will automatically update the communications and processing server database 34, notify the substitute fulfillment system 10 of the absence, and trigger the substitute fulfillment process."

From this passage, it is again clear that the system *automatically* receives updated applets from an organization regarding worker absences. The system of Thompson et al. has automatically identified a window of opportunity, as the system has been made aware of worker absence without requiring direct user input.

The user has not directly provided information to the system taught by Thompson et al. Rather, the system is made aware of windows of opportunity when it receives updates made to the communications and processing server database.

The Examiner will present further indication that the Thompson et al. reference automatically identifies/detects windows of opportunity.

In Column 5, lines 4-9, and 12-17: "Generally, at least one presently preferred embodiment of the present invention contemplates that a substitute fulfillment, information compilation or notification system includes a main server that manages

substitute fulfillment, compilations and notifications for multiple client organizations... Organizations enter substitute fulfillment data and contact data locally at the organization and transmit the data to the server. An organization maintains its own parallel database on a local application. The system periodically sends updates to and receives updates from an organization's local database."

Clearly, a participating organization of the substitute fulfillment system maintains its own record of required substitutes (resulting from employee absences). Organizations simply update their own records, which propagates to the substitute fulfillment system, and automatically triggers a responsive action to provide an adequate substitute.

In Column 5, lines 18-20: "In one preferred embodiment, an employee registers an absence and triggers the automated substitute fulfillment procedure by contacting the substitute fulfillment system."

This embodiment reinforces the notion that the substitute fulfillment procedure is fully automated. It has been established that, even when the user directly inputs the absence information, that step is automated; thus, the system taught by Thompson et al. automatically identifies/detects windows of opportunity.

In Column 5, lines 46-47: "The system may also track the absences of each particular worker and the worker's entitlements."

In other words, the system monitors the main server that manages substitute fulfillment, compilations and notifications for multiple client organizations in order to identify/detect windows of opportunity.

In Column 8, lines 19-28, "In a preferred embodiment, the applet resides locally on the client's computer 54 and functions independently of the main server 30 for most of its functions. The applet is primarily a data entry and reporting and Internet communications tool.....The applet is primarily a data entry and reporting and Internet communications tool. Once the organization has received the applet, the organization must enter data to initialize the applet and the substitute fulfillment system for its use.

Column 8, lines 56-60: "When the initial data entry is complete, in step 74, the customer instructs the applet to transmit the data to the communications and processing server 30 to initialize the system 10. The applet communicates with the communications and processing server 30 via the Internet."

Column 10, lines 17-18: "Once the system 10 has been initialized, the system is ready to operate".

When the applet transmits (updated) data, the system taught by Thompson et al. is thereby initialized. The Thompson et al. system then automatically identifies/detects windows of opportunity based on data received from the applet, or other sources.

Column 8, lines 35-37: "The applet is preferably tailored to collect data needed to perform substitute fulfillment in the work environment of the organization."

Conceivably, such information includes indication of a need to substitute workers. For example, any entered information regarding an organization's employee absences would be maintained on said organization's local database. Since the applet collects data relevant to the need for substitute fulfillment, and is transmitted to the system of Thompson et al., the Thompson et al. system is therefore enabled to automatically identify/detect windows of opportunity.

The Thompson et al. reference is computer implemented. Computers enable the *automation* of tasks; thus, any actions performed by the computer-implemented system are considered to have been automated. Therefore, Thompson et al. teaches a system that automatically identifies windows of opportunity.

As evidenced by the passages presented above, employee absences can be directly input by users (using automated processing techniques) that trigger the system taught by Thompson et al.; or indirectly input by users, in which case the system taught

by Thompson et al. automatically detects received updates or identifies employee absences from monitoring substitute notifications from member organizations.

While it is true that in most of the embodiments presented in Thompson et al. involve some degree of user input, the claimed invention does not preclude user interaction. Thompson et al. has established a plurality of embodiments in which worker substitution information is automatically obtained, which further triggers an automated process.

Coupled with the fact that the system of Thompson et al. is computer-implemented, thereby automating all tasks performed by said system (including data collection), when the system identifies/detects windows of opportunity, it is thereby *automatically* detected/identified.

Furthermore, it was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In addition, it is well settled that it is not an "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

In response to applicant's argument that there is no suggestion to combine the Thompson et al. and English references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings). See also *In re Lee,* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references).

In this case, the Examiner respectfully disagrees. The Applicant has chosen to embody convenient embodiments of the references to argue a lack of motivation to

combine the references, instead of considering the teachings of the references on its fundamental concept and on their merits. The Examiner submits that both Thompson et al. and the English reference are directed towards the analogous art of providing emergency services in response to [automatically] identified unscheduled/unplanned events. The logic is as follows:

Inherently, the circumstances requiring the use of the OnStar emergency services are of an unplanned/unscheduled nature. Accidents, flat tires, dead car batteries, medical emergencies, etc. are all instances of unplanned/unscheduled events that require the OnStar services.

Providing substitute workers is analogous to arranging for the OnStar service of providing emergency response services. OnStar provides emergency response services; Thompson et al. provides a substitute worker, who provides an "emergency service" of fulfilling the otherwise vacant role of an absent worker.

Furthermore, Column 6, lines 1-7 of Thompson et al. suggests a motivation to combine with a system, such as the OnStar service discussed by the English reference: "It is understood that "workplace" or "organization" or "entity" *when used in this application refers not only to more traditional work environments, but to any work environment amenable to substitute fulfillment, information compilation or notification*,

such as an employee unit that works cooperatively together within a larger organization, *for example, an emergency services unit.*"

OnStar itself compiles information (regarding the circumstances of the customer requesting assistance, the potential service providers, etc.) and provides emergency services to assist users.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Choi
Examiner
Art Unit 3623

PC

November 22, 2005

Susanna Diaz

SUSANNA M. DIAZ
PRIMARY EXAMINER
AU 3623